



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/472,110	12/27/1999	HERBERT E. SCHWARTZ	FZIO01000US4	8339

23910 7590 10/23/2002

FLIESLER DUBB MEYER & LOVEJOY, LLP
FOUR EMBARCADERO CENTER
SUITE 400
SAN FRANCISCO, CA 94111

EXAMINER

OWENS JR, HOWARD V

ART UNIT	PAPER NUMBER
----------	--------------

1623

DATE MAILED: 10/23/2002

10

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/472,110

Applicant(s)

SCHWARTZ ET AL.

Examiner

Howard V Owens

Art Unit

1623

– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-94 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-94 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Election/Restrictions

I. Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-29 and 94, drawn to a gel composition classified in class 514, subclass 45+.
- II. Claims 30-39, drawn to a method of manufacturing a gel, classified in class 514, subclass 45+.
- III. Claims 40-43, 47, 48, 91-93 drawn to a method of treating post surgical adhesions, classified in class 514, subclass 45+.
- IV. Claims 44-46, 50 drawn to a method for treating sinusitis with a compound of claim 1, classified in class 514, subclass 45+.
- V. Claim 51, drawn to a method for decreasing surgical trauma with a compound of claim 1, classified in class 514, subclass 45+.
- VI. Claim 52, drawn to a method of decreasing friction between tissues, classified in class 514, subclass 45+.
- VII. Claims 53, drawn to a method of coating catheters, classified in class 514, subclass 422+.
- VIII. Claim 56, drawn to a method of conditioning a polyacid membrane, classified in class 536, subclass 30+.

- IX. Claims 57-85, drawn to a carboxypolysaccharide composition, classified in class 536, subclass 30+.
- X. Claims 86-90, drawn to a method of manufacturing a composition, classified in class 536, subclass 30+.

II. The inventions are distinct, each from the other because of the following reasons:

Inventions I-IV are related as distinct methods of use for the same compound. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). Although the inventions of Groups I-V are related as compounds containing a polyacid gel, it is noted that each of the compounds can be used in a materially different method. Groups III-VIII are related as different methods of use for the same gel. Groups IX and X are related as product and process of making, diverse from the components and methods of manufacture set forth in Groups I and II.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and the search required for Groups I and II is not required for Groups IX and X; moreover, a search in the divergent areas would indeed impose an undue burden on the examiner in charge of the application, restriction for examination purposes as indicated is proper. Should applicant elect Groups I and II any one of the methods of use claims set forth in Groups III-VIII will be examined as well.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the

Art Unit: 1623

currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Species Election

Of the numerous distinct species claimed for the polyacid, polyakylene oxide, and multivalent cation components, the following species were elected during a telephone conversation on 9/17/02 with applicant's representative, Benjamin Borson.

Species 1 - For the Polyacid, carboxypolysaccharide, carboxymethyl or carboxyethyl cellulose class 514, subclass 47.

Species 2 - For the Polyalkylene oxide, polyethylene oxide, classified in class 514 subclass, 49.

Species 3 - For the multivalent cation, a divalent cation, classified in class 424 subclass, 617.

Species 4 - For the drugs, antithrombogenic drugs, classified in class 514 subclass, 46.

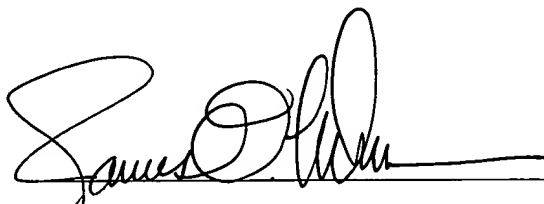
Applicant has initially elected the species cited supra under 35 U.S.C. 121 for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. However, a written restriction was requested for the remaining Groups. Currently, claim 1 is generic.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the

Art Unit: 1623

limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Howard V. Owens
Patent Examiner
Art Unit 1623



James O. Wilson
Supervisory Patent Examiner
Technology Center 1600

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Howard Owens whose telephone number is (703) 306-4538 . The examiner can normally be reached on Mon.-Fri. from 8:30 a.m. to 5 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the Supervisory Patent Examiner signing this action, James O. Wilson can be reached on (703) 308-4624 . The fax phone number for this Group is (703) 308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1235.